

**REMARKS**

Applicant appreciates the Examiner's withdrawal of all previously cited prior art and indication that the claimed subject matter is not rejected on grounds of prior art. Accordingly, the only basis for rejections is 35 USC §112. Each of these is addressed in turn.

**Status of Claims 68 and 77**

Applicant traverses the Office Action (January 19, 2010) contention that previously withdrawn Claim 68, which is dependent from allowed Claim 59, will not be allowed to issue in this application. Claim 59 is *per se* a "generic" claim if Claim 68 depends from it. Likewise, previously withdrawn Claim 77 is patentable and depends from patentable generic Claim 70. Claims 68 and 77 each add the same feature to their respective independent claims, and cannot be unpatentable over cited art that does not render their parent claims unpatentable. Accordingly, there is no logical basis to force Applicant to the expense of filing a divisional application to obtain patent rights to the subject matter of two claims.

The Patent Office has had three Requests for Continuing Examination and associated fees in this application to date, and the Examiner has had his benefits. Accordingly, notwithstanding the alleged "election of species without traverse," and because Claims 59 and 70 are generic, Applicant hereby provides fair notice that it will Petition the Director of Patent Office if Claims 68 and 77 are not reinstated and allowed.

**Each orifice injecting iodine at right angles . . .**

The Office Action objects that there is no language in the text that specifically uses the language: ". . . each orifice injecting iodine at right angles to a tangent to a curvature of a strut surface at the orifice."

The Examiner is respectfully reminded that the Drawing Figures accompanying the application form part of the Specification. The MPEP § 608.04 (a) defines “new matter” and states that: “Matter not in the original specification, claims, or drawings is usually new matter.” Accordingly, any matter that is **in** the original specification, drawings and claims is NOT new matter. In this instance, original FIG. 1 shows a strut 14 that has several injector nozzles 16, through which iodine ( $I_2$ ) is being injected. It has never been held necessary for the exact wording of the claim to be spelled out in the text of the specification for support, as long as it is shown in the drawings. In this case, the Examiner is invited to use proper instruments and see for himself that the iodine sprays, shown as symmetrical spray forms in FIG. 1, each has a center line. The center lines that the Examiner may draw will each be at right angles to a tangent to the curvature of strut 14, at the point of location of each nozzle.

The feature that the Examiner objects to is *clearly illustrated*, and that is sufficient to meet the requirements of the statute and the Rules. We note the Examiner’s failure to cite to the Rules or MPEP in the present Office Action to provide Applicant with notice of legal support for his position regarding lack of support for the language in the claims. In the event the Examiner has any authority from the MPEP and Rules, and is withholding these for whatever reason, then the present Office Action is “incomplete” in violation of MPEP 707 (g) which cautions against piecemeal Office Actions.

Reconsideration and withdrawal of the basis for claim rejection is urged.

**The exit plane . . . the laser cavity**

The language has been amended to “an exit plane,” and to “a laser cavity.”

**The preamble of Claim 59 is appropriate**

Applicant respectfully submits that the Examiner is misreading the preamble of Claim 59. The preamble clearly reads as follows:

“An iodine injection system for injecting iodine into gas flowing through a nozzle for a laser, *the system* comprising:”

Accordingly, all language that follows after the words “the system comprising” are components of *the system*. Applicant sees no error in the preamble. Reconsideration and withdrawal of the basis for claim rejection is urged.

**“Proximate” is not an indefinite term**

Applicant respectfully submits that the term “proximate” is commonly used in patent claims and is NOT indefinite. The Patent Statute and Rules do not require mathematical precision, and terms such as “substantially,” “about 50%” and “insignificant amounts” are all acceptable in patent claims, *as well as the term “proximate.”* Indeed, a cursory search of the U.S. Patent Office database of issued patents (at [uspto.gov](http://uspto.gov)) for the word “proximate” appearing in patent claims produced a search result of over **90,000** patents! Either the Examiner is mistaken, or his colleagues have merrily been issuing 90,000 patents with “indefinite” claims over many years! Since the latter scenario is unlikely, Applicant respectfully submits that the Examiner is mistaken as to the word “proximate” being legally indefinite for patent purposes. Reconsideration and withdrawal of the basis for claim rejection is urged.

**“When the system is in use”**

The Examiner objects to this language as indefinite in Claim 70. The Claim is clearly directed to a system and not to a method or process. Accordingly, it merely states what happens

when the system is used. This type of language has never before been held “indefinite,” just as “proximate” is not indefinite, and just as “whereby” clauses are not indefinite. However, to facilitate prosecution, and since the language is not necessary for patentability, it has been removed to broaden the claimed subject matter.

### **Amended Claims**

Claims 59 and 72-76 have been amended to correct for antecedent basis. Claims 70 and 78 have also been amended.

### **Conclusion**

Applicant does not believe that any fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper, to Deposit Account 50-2180 of Storm LLP.

Should the Examiner require any further clarification to place this Application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

Dated: September 2, 2010

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